UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,071	09/27/2001	Terrence Sick	1093 006 301 0202	2718

37211   7590   02/28/2008

BASCH & NICKERSON LLP
1777 PENFIELD ROAD
PENFIELD, NY 14526

EXAMINER
CHANDLER, SARA M

ART UNIT	PAPER NUMBER
3693	

NOTIFICATION DATE	DELIVERY MODE
02/28/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dneels@bnpatentlaw.com
dmasters@bnpatentlaw.com
mnickerson@bnpatentlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/965,071
Filing Date: September 27, 2001
Appellant(s): SICK ET AL.

Duane C. Basch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/04/08 appealing from the Office action

mailed 05/04/07.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| 5991751 | Rivette | 11-1999 |
| 6012042 | Black | 1-2000 |

Documentary Evidence:

patent assignee dialog- Google News Archive Search (1980-2000)

patent assignee lexisnexis - Google News Archive Search (1980-2000)

patent assignee stn - Google News Archive Search (1980-2000)

ticker dialog business or finance economic - Google News Archive Search (1980-2000)

ticker lexisnexis business or finance or economic - Google News Archive Search (1980-2000).

patent ticker dialog business or finance - Google News Archive Search (1980-2000).

patent ticker dialog business or finance - Google News Archive Search (1980-2000).

patent ticker lexisnexis business or finance - Google News Archive Search (1980-2000)

(9) Grounds of Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-6, 8,9,11-13,15-17 are rejected under 35 U.S.C. 102(e) as being

anticipated by Rivette, US Pat. No. 5,991,751.

Re Claim 3: Rivette discloses in an on-line service, a method for screening financial

investment opportunities, comprising the steps of:

searching a financial database, including data for a plurality of companies, for data

records associated with at least one company based upon a financial search criteria

and retrieving the results thereof (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col.

10, lines 8+ - col. 13, line 24; col. 25, line 39+ - col. 30, line 6 searching module; Figs.

1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7;

col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45; col. 16, lines

42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial

information, databases) ;

searching an intellectual property database, including data for a plurality of companies,

for data records associated with the at least one company based upon an intellectual

property search criteria and retrieving the results thereof (Rivette, abstract, col. 1, line

1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; col. 25, line 39+ - col. 30, line 6

searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-

21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).

combining the results of the financial database searching step and the

intellectual property database searching step to determine common results on a

company basis (Rivette, Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 1-7; col. 12,

lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 "automatically analyzing the patent

information 204 in conjunction with the financial information 216"); and

depicting the combined results (Rivette, Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11,

lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 "automatically

analyzing the patent information 204 in conjunction with the financial information 216").

Re Claim 4: Rivette discloses a method, wherein the method further comprises the

step of analyzing the number of common results on a company basis to determine if

the number is greater than zero (Rivette, col. 25, line 39+ - col. 30, line 6 searching

module), and

if not relaxing the search criteria employed in at least one of the searching steps

and rerunning the searches so as to obtain a non-zero number of common results

(Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

Re Claim 5: Rivette discloses a method, wherein the step of relaxing the search criteria

is accomplished without user intervention (Rivette, col. 25, line 39+ - col. 30, line 6

searching module).

Re Claim 6: Rivette discloses a method, further including the step of maintaining the

financial database data records and the intellectual property database records,

wherein the step includes periodically launching an automated search of network

resources to locate and update financial and intellectual property information', and

storing the updated information in the respective database (Rivette, col 16, line 19+ -col.

22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module).

Re Claim 8: Rivette discloses a method, further including the step of constructing a

search query having both financial search criteria and intellectual property search

criteria (Rivette, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 4-7; col. 25, line 39+ - col.

30, line 6 searching module).

Re Claim 9: Rivette discloses a method, wherein the step of constructing a search

query having both financial search criteria and intellectual property search criteria is

facilitated by the step of displaying a search construction interface to a user (Rivette,

col. 2, lines 61+ - col. 3, line 9; col. 11, lines 4-7; col. 25, line 39+ - col. 30, line 6

searching module).

Re Claim 11: Rivette discloses a system for screening financial investment

opportunities, comprising (Rivette, Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23):

a computer platform responsive to user input including access to at least a

financial database including data records associated with a plurality of companies and

an intellectual property database including data records associated with a plurality of

companies (Rivette, Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16,

line 19+ -col. 22, line 24 databases; abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines

8+ - col. 13, line 24);

programmable search software, operable by said computer platform, for

searching the financial database for data records associated with at least one

company based upon a financial search criteria and retrieving the results thereof

for storage in a first memory, said programmable search function also being

employed for searching the intellectual property database for data records

associated with at least one company based upon an intellectual property search

criteria and retrieving the results thereof for storage in a second memory (Rivette, col.

14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching

module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col.

11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45;

col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information,

financial information; F igs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line

15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information);

search analysis software, operable by said computer platform, for

combining the results of the financial database search and the intellectual property

database search to determine common results(Rivette, col. 14, lines 55-67; col. 15,

lines 15-23 software; Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 1-7; col. 12,

lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 "automatically analyzing the patent

information 204 in conjunction with the financial information 216"); and

a display device for depicting the common results (Rivette, col. 15, line 5-8 display unit;

Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 1-7; col. 12, lines 43-52; col. 13,

lines 1-11; col 20, lines 12-21 "automatically analyzing the patent information 204 in

conjunction with the financial information 216").

Re Claim 12: Rivette discloses a system, wherein said computer platform includes a

client and a server interconnected by a network, and where the financial database

and the intellectual property database are stored on devices accessible through

said server Rivette, Figs. 3 e.g., clients, network, servers, databases ,4,5,6; col. 13, line

26+ - col. 15, line 23.

Re Claim 13: Rivette discloses a system, further including means for automatically

relaxing search criteria employed by the programmable search software so as to

obtain a non-zero number of search results (Rivette, col. 25, line 39+ - col. 30, line 6

searching module).

Re Claim 15: Rivette discloses a system, wherein said display device is suitable for the

display of at least one user-selectable data item to assist with the construction of a search query having both financial search criteria and intellectual property search criteria (Rivette, col. 15, line 5-8 display unit; col. 25, line 39+ - col. 30, line 6 searching module).

Re Claim 16: Rivette discloses a method for processing a search request having financial search criteria, comprising:

sending the search request to a financial database, the financial database including at least financial data for a plurality of companies (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module);

receiving results, in response to the search request, from the financial database having at least one data record corresponding to the financial search criteria (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module);

determining that the search request includes intellectual property search criteria (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information; F igs. 12a-m; abstract; col. 3, line 59+ - col. 4,

line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref.

patent information);

filtering said results for data records corresponding to said intellectual

property search criteria (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col.

25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ -

col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines

65+ - col. 13, line 7; col. 15, liens 37-45; col. 16, lines 42-52; and col. 21, lines 59+ -

col. 22, line 6 refs. non-patent information, financial information; F igs. 12a-m; abstract;

col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col.

16, lines 53-67 ref. patent information); and

presenting said filtered results (Rivette, col. 9, line 65+ -col. 10, line 3 ie., reporting,

analyzing and planning; col. 20, lines 42-52).

Re Claim 17: Rivette discloses a method for processing a search request having

intellectual property search criteria, comprising:

sending the search request to an intellectual property database, the intellectual property

database including at least intellectual property data for a plurality of companies

(Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; Figs.

3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24

databases; col. 25, line 39+ - col. 30, line 6 searching module);

receiving, in response to the search request, results from the intellectual property

database having at least one data record corresponding to the intellectual property

search criteria (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col.

13, line 24; Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -

col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module);

determining that the search request includes financial search criteria (Rivette, col. 14,

lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching

module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col.

11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45;

col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information,

financial information; F igs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line

15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information);

filtering said results for data records corresponding to said financial search

criteria (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col.

30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col.

10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7;

col. 15, liens 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-

patent information, financial information; F igs. 12a-m; abstract; col. 3, line 59+ - col. 4,

line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref.

patent information); and

presenting said filtered results (Rivette, col. 9, line 65+ -col. 10, line 3 ie., reporting,

analyzing and planning; col. 20, lines 42-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette,

US Pat. No. 5,991,751.

Re Claim 10: Rivette fails to explicitly disclose a method, wherein said step of

combining the results of the financial database searching step and the intellectual

property database searching step, further comprises accessing an assignee/ticker

database to determine linkages between the financial database and the intellectual

property database on a company basis. Official Notice is taken that it is old and well-

known that publically available financial and intellectual property data concerns

assignee and ticker data . For example, ticker information is used in investment reports,

searching SEC documents and is published in newspapers. For example, assignee

information is available in patent search databases. It would have been obvious to one

of ordinary skill in the art at the time of the invention to modify the teachings of Rivette

to provide a method, wherein said step of combining the results of the financial

database searching step and the intellectual property database searching step, further

comprises accessing an assignee/ticker database to determine linkages between the

financial database and the intellectual property database on a company basis. As

suggested by Rivette one would have been motivated to use publicly available patent

related information and non-patent related information (e.g., financial information) to

make business decisions.

(Documentary Evidence)
Patent Assignee as Patent or Intellectual Property Information in searching and
databases
(1) Dialog

patent assignee dialog – Google News Archive Search (1980-2000). (5 pages)

(2) LexisNexis

patent assignee lexisnexis – Google News Archive Search (1980-2000). (1 page)

(3) STN

patent assignee stn – Google News Archive Search (1980-2000). (2 pages)

Ticker Information as Business, Finance or Economic Information in searching and
databases
(1) Dialog

ticker dialog business or finance or economic – Google News Archive Search (1980-

2000). (23 pages)

(2) LexisNexis

ticker lexisnexis business or finance or economic – Google News Archive Search (1980-

2000). (13 pages)

Patent or Intellectual Property Information and Business, Finance or Economic
Information in searching and databases

(1) Dialog

patent ticker dialog business or finance- Google News Archive Search (1980-2000). (2

pages)

(2) LexisNexis

patent ticker dialog business or finance- Google News Archive Search (1980-2000). (1

page)

(3) STN

patent ticker lexisnexis business or finance- Google News Archive Search (1980-2000).

(1 page)

Claims **1,2,7 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rivette, US Pat. No. 5,991,751 in view of Black, US Pat. No. 6,012,042.

Re Claim 1: Rivette discloses in an on-line financial screening service, a method of

searching a financial database, including data for a plurality of companies, and an

intellectual property database, including data for a plurality of companies, in order to find

securities matching user search criteria and relevant intellectual property, wherein the

users access the database over the Internet (Rivette, abstract, col. 1, line 1+ - col. 4,

line 30; col. 10, lines 8+ - col. 13, line 24), the method comprising:

searching the database for records matching financial search criteria

defined by a user (Rivette, Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10,

lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col.

15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-

patent information, financial information, databases); and

relaxing at least some of the search criteria, until at least a required number

of matching records are found, wherein the required number of matching records

is never less than one (Rivette, col. 25, line 39+ - col. 30, line 6 searching module); and

reporting the matching records to the user (Rivette, col. 9, line 65+ -col. 10, line 3 ie.,

reporting, analyzing and planning; col. 20, lines 42-52).

Rivette fails to explicitly disclose a method wherein reporting the matching

records to the user, includes at least one item of data selected from the group

consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio,

Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per Share Growth-lYr,

Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio

Black discloses a method wherein reporting the matching records to the user,

includes at least one item of data selected from the group consisting of Stock Price,

Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per

Share Growth- 1Yr, Earnings per Share Growth-lYr, Insider Trades, Institutional

Holdings %, Price/Book Ratio, and Price/cash Flow Ratio (Black, Figs. 3 and 4; col. 1,

lines 45-65; and col. 2, lines 8-41 financial information).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Rivette by adopting the teachings of Black to

provide in an on-line financial screening service, a method of searching a

financial database and an intellectual property database in order to find securities

matching user search criteria and relevant intellectual property, wherein the users

access the database over the Internet, the method comprising: searching the database

for records matching financial search criteria defined by a user; and relaxing at least

some of the search criteria, until at least a required number of matching records are

found, wherein the required number of matching records is never less than one; and

reporting the matching records to the user, including at least one item of data selected

from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio,

Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per

Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and

Price/cash Flow Ratio.

As suggested by Rivette one would have been motivated to use publicly

available patent related information and non-patent related information (e.g., financial

information) to make business decisions.

Re Claim 2: Rivette discloses a method, wherein the search criteria is suitable for

being delimited between a minimum and maximum (Rivette, col. 25, line 39+ - col. 30,

line 6 searching module).

Re Claim 7: Rivette discloses a method, wherein the updated information includes:

financial data (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6;

abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12,

lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45; col. 16, lines 42-52;

and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information,

databases), and

at least one item of intellectual property data selected from the group

consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State,

Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification,

Assignee Name, Assignee State, Assignee Country, Issued US Classification,

International Classification, Application Serial Number, Application Date, Primary

Examiner, Assistant Examiner, Parent Case Information, Related US App. Data,

US References, Reissue Data Foreign References, Foreign Priority, PCT

Information, Government Interest, and Application Type (Rivette, col. 25, line 39+ - col.

30, line 6 searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4,

line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent

information).

Rivette fails to explicitly disclose a method, wherein the updated information

includes:

at least one item of financial data selected from the group consisting of

Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price

ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider

Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio,

Black discloses a method, wherein the updated information includes:

at least one item of financial data selected from the group consisting of

Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price

ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades,

Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio (Black, Figs. 3

and 4; col. 1, lines 45-65; and col. 2, lines 8-41 financial information).

.   It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Rivette by adopting the teachings of Black to

provide in an on-line service, a method for screening financial investment

opportunities, comprising the steps of: searching a financial database for data records

associated with at least one company based upon a financial search criteria and

retrieving the results thereof; searching an intellectual property database for data

records associated with at least one company based upon an intellectual property

search criteria and retrieving the results thereof; combining the results of the financial

database searching step and the intellectual property database searching step to

determine common results on a company basis; and depicting the combined results.

As suggested by Rivette one would have been motivated to use publicly

available patent related information and non-patent related information (e.g., financial

information) to make business decisions.

Re Claim 14: Rivette discloses a system, including a financial database includes

records having financial data (Rivette, col. 25, line 39+ - col. 30, line 6 searching

module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col.

11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45;

col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information,

financial information, databases), and

where said intellectual property database includes records having at least

one item of intellectual property data selected from the group consisting of Patent

Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor

Country, Claims), Attorney or Agent, Description/specification, Assignee Name,

Assignee State, Assignee Country, Issued US Classification, International

Classification, Application Serial Number, Application Date, Primary Examiner,

Assistant Examiner, Parent Case Information, Related US App. Data, US

References, Reissue Data Foreign References, Foreign Priority, PCT Information,

Government Interest, and Application Type (Rivette, col. 25, line 39+ - col. 30, line 6

searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-

21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).

Rivette fails to explicitly disclose a system, wherein said financial database

includes records having at least one item of financial data selected from the group

consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio,

Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-

1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash

Flow Ratio.

Black discloses a system, wherein said financial database includes records

having at least one item of financial data selected from the group

consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio,

Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-

1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash

Flow Ratio (Black, Figs. 3 and 4; col. 1, lines 45-65; and col. 2, lines 8-41 financial

information).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Rivette by adopting the teachings of Black to

provide a system, wherein said financial database includes records having at least one

item of financial data selected from the group consisting of Stock Price, Price/Earnings

Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-

lYr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %,

Price/Book Ratio, and Price/cash Flow Ratio, and where said intellectual property

database includes records having at least one item of intellectual property data selected

from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor

State, Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification,

Assignee Name, Assignee State, Assignee Country, Issued US Classification,

International Classification, Application Serial Number, Application Date, Primary

Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US

References, Reissue Data Foreign References, Foreign Priority, PCT Information,

Government Interest, and Application Type.

As suggested by Rivette one would have been motivated to use publicly

available patent related information and non-patent related information (e.g., financial

information) to make business decisions.

(10) Response to Argument

All claims were examined and interpreted in accordance with guidelines set forth

in the MPEP which states:

> Although the claims are interpreted in light of the specification, limitations from
> the specification are not read into the claims. See *In re Van Geuns*, 988
> F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See MPEP § 2145 VI.
>
> Applicant always has the opportunity to amend the claims during prosecution,
> and broad interpretation by the examiner reduces the possibility that the claim,
> once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415
> F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.
>
> If more than one extrinsic definition is consistent with the use of the words in the
> intrinsic record, the claim terms may be construed to encompass all consistent
> meanings. See e.g., *Rexnord Corp. v. Laitram Corp.* 274 F.3d 1336, 1342, 60
> USPQ 185: 1854. See MPEP § 2111.01 III.

102

Claims 3-6, 8, 9, 11-13 and 15-17 – 102(e) anticipation, Rivette

Re claims 3,11,12, 16 and 17: First, in response to applicant's argument that

the references fail to show certain features of applicant's invention, it is noted that the

features upon which applicant relies (i.e., Rivette does not disclose or suggest the

management of patent (intellectual property) and non-patent (financial information) from

multi-company databases by referencing such information to make a decision) are not

recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re*

Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claimed invention recites:

Claim 3:   In an on-line service, a method for screening financial
investment opportunities, comprising the steps of:

searching a financial database, including data for a plurality of companies, for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof;

searching an intellectual property database, including data for a plurality of companies, for data records associated with the at least one company based upon an intellectual property search criteria and retrieving the results thereof;

combining the results of the financial database searching step and the intellectual property database searching step to determine common results on a company basis; and

depicting the combined results.

Claim 11: A system for screening financial investment opportunities, comprising:

a computer platform responsive to user input including access to at least a financial database including data records associated with a plurality of companies and an intellectual property database including data records associated with a plurality of companies;

programmable search software, operable by said computer platform, for searching the financial database for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof for storage in a first memory, said programmable search function also being employed for searching the intellectual property database for data records associated with the at least one company based upon an intellectual property search criteria and retrieving the results thereof for storage in a second memory;

search analysis software, operable by said computer platform, for combining the results of the financial database search and the intellectual property database search to determine common results; and

a display device for depicting the common results.

In other words, all that is claimed is: (a) A financial database that has any data concerning more than one company; searching the financial database for a data record regarding at least one company using financial search criteria; and retrieving the results.

(b) All that is claimed is a intellectual property database that has any data concerning more than one company; searching the intellectual property database for a data record regarding at least one company using the intellectual property search criteria; and retrieving the results.

Second, Rivette discloses the claimed subject matter. Rivette states:

Briefly stated, the present invention is directed to a system, method, and computer program product for processing data. The present invention maintains first databases of patents, and second databases of non-patent information of interest to a corporate entity.

The present invention also maintains one or more groups. Each of the groups comprises any number of patents from the first databases. The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases. Accordingly, the present invention performs patent-centric and group-oriented processing of data. (Rivette, col. 3, lines 59 - col. 4, line 4)

When Rivette discloses that a "non-patent information" database can be searched (i.e., such as a database of financial information), the data contained in the database is for a plurality of companies. For example Rivette suggests that the non-patent information "of interest" can pertain to variety of legal and/or financial papers). Thus, at a minimum that database would hold data for other companies such as financiers, partners, competitors etc. (Rivette, Fig. 2, col. 10, lines 17-22).

For example, Rivette states:

The financial databases 638 store financial information pertaining to the customer's business. The financial databases 638 may also include financial information on a competitor's businesses (to the extent that such information is publicly known, or can be determined or estimated based on publicly known information or business practices. (Rivette, col. 21, line 64)

Patents are issued to a plurality of companies. When Rivette discloses that patents "of interest" can be searched in the patent database that means that patents for a plurality of companies can be searched (e.g., a company, it's competitors). Rivette suggests, that there is an interest in providing this sort of data for a plurality of

companies in cases such as patent infringement, competition etc. (See Rivette Fig. 2,

col. 1 lines 36-48; col. 2, lines 29-33; and col. 3, lines 52-56).

For example, Rivette states the following regarding the shortcomings of the prior

art:

> However, these tools have limited, if any, automated functions to aid a user in
> analyzing the patents, whether the company's own patents or those of
> competitors, for the purpose of making tactical and strategic business decisions
> based on the patents. (Rivette, col. 1, lines 36-38)

Third, the language "including data for a plurality of companies" does not change

the invention.

The MPEP states:

> USPTO personnel should begin claim analysis by identifying and evaluating
> each claim limitation. For processes, the claim limitations will define steps or
> acts to be performed. For products, the claim limitations will define discrete
> physical structures or materials. Product claims are claims that are directed to
> either machines, manufactures or compositions of matter.

See MPEP § 2106 II C.

> The subject matter of a properly construed claim is defined by the terms that limit
> its scope. It is this subject matter that must be examined. As a general matter,
> the grammar and intended meaning of terms used in a claim will dictate whether
> the language limits the claim scope. Language that suggests or makes optional
> but does not require steps to be performed or does not limit a claim to a
> particular structure does not limit the scope of a claim or claim limitation. The
> following are examples of language that may raise a question as to the limiting
> effect of the language in a claim:
>
> (A) statements of intended use or field of use,
> (B) "adapted to" or "adapted for" clauses,
> (C) "wherein" clauses, or
> (D) "whereby" clauses.

See MPEP § 2106 II C.

As noted supra, a method claim is defined by the steps or acts performed. The

steps or acts performed by the method include: "searching a financial database, ..., for

data records associated with at least one company based upon a financial search

criteria....." and "searching an intellectual property database, ..., for data records

associated with the at least one company based upon an intellectual property search

criteria....." As noted supra, a system claim is defined by it's discrete physical

structures. The system claimed provides software for performing the steps or acts

claimed by the method.

The language "including data for a plurality of companies" is not tied to any of the

actively recited steps or acts performed by the method or the discrete physical structure

required of the system. The language "including data for a plurality of companies" is

directed only to the specific compilation of data stored in the database. Whether the

data stored in the database is for one, two or any one of an infinite number of

companies however, does not alter the ability to search a financial database for data

records associated with at least one company based upon a financial search criteria; or

to search an intellectual property database for data records associated with the at least

one company based upon an intellectual property search criteria as claimed. Thus,

"including data for a plurality of companies" does not contribute to the functionality of the

claimed invention and it is not critical to the method or system claimed.

In other words, the claimed invention is only required to search the database for

the data records of one company. The claimed invention is not required to search the

database for the data records of a plurality of companies. In fact, the claimed invention

is not required to do anything on behalf of a plurality of companies.

The claimed invention recites:

Claim 16: A method for processing a search request having financial search criteria,
comprising:
        sending the search request to a financial database, the financial database including at least financial data for a plurality of companies;
        receiving, in response to the search request, results from the financial database having at least one data record corresponding to the financial search criteria;
        determining that the search request includes intellectual property search criteria
        filtering said results for data records corresponding to said intellectual property search criteria; and
        presenting said filtered results.

Claim 17: A method for processing a search request having intellectual property search criteria, comprising:
        sending the search request to an intellectual property database, the intellectual property database including at least intellectual property data for a plurality of companies;
        receiving, in response to the search request, results from the intellectual property database having at least one data record corresponding to the intellectual property search criteria;
        determining that the search request includes financial search criteria;
        filtering said results for data records corresponding to said financial search criteria; and
        presenting said filtered results.

Claims 16 and 17 are rejected based on the similar rationale as claims 3 and 11

above. In claims 16 and 17 however, there is no requirement that the data records are

for one company or a plurality of companies.

Re Claims 4,5 and 13: The claims have been given their broadest reasonable

interpretation consistent with MPEP § 2111. The limitation "analyzing the number of

common results on a company basis to determine if the number is greater than zero,

and if not relaxing the search criteria employed in at least one of the searching steps

and rerunning the searches so as to obtain a non-zero number of common results" is

interpreted as being synonymous with modifying, adjusting or manipulating search

terms or criteria. This is what is done during a search however. In other words,

restrictive search constraints are removed until a result is achieved (i.e., a zero number

of common results is equivalent to saying no result; and a non-zero number of common

results is equivalent to saying a result).

For example, if a user is searching for a person named John Doe in California he

may conduct search of individuals with that name. If the user receives too many results

he would "modify, adjust or manipulate" the search terms or criteria by narrowing the

scope by adding requirements (e.g., John Doe resides in Orange County, is between

50-60 and is male) which will likely reduce the number of matching results. If the user

does not receive any results or too few results he would "modify, adjust or manipulate"

the search terms or criteria by broadening the scope by relaxing the requirements (e.g.,

John Doe could be John Don, or California could be the West Coast/Region). Thus

language in the description of the search module such as "iterative" (Rivette, col. 26,

lines 24-28); "search strategies" (Rivette, col. 26, lines 29-33); "manipulate" (Rivette,

col. 26, lines 40-46) are interpreted as reading upon the claim language. See also,

Rivette, col. 26, lines 7-16.

Re Claim 6: The limitation, "maintaining the financial database data records and the

intellectual property database records, wherein the step includes periodically launching

an automated search of network resources to locate and update financial and

intellectual property information; and storing the updated information in the respective

database" is disclosed by Rivette.

> For example, Rivette states:

> Many of the databases 316, such as the BOM databases 626, the inventor
> databases 628, and corporate databases 630, the financial databases 638, the
> person databases 632, and the employee databases 634, are initially loaded
> using information from the customer...... After initial loading, these databases
> are updated as necessary to reflect changes in the customer's information.
> (Rivette, col. 16, lines 42-52)

> The patent bibliographic databases 604 may be periodically updated through a
> subscription service from such third party providers. Similarly, the patent
> database 614 may be augmented through as-needed orders to the third party
> providers. It should be understood that the present invention works equally well
> with data provided by any party as long as the data's formats matches the
> formats of the patent bibliographic databases 604 and the patent database 614.
> (Rivette, col. 16, lines 59-67)

Re Claims 8 and 9: The limitation, "constructing a search query having both financial

search criteria and intellectual property search criteria" is disclosed by Rivette.

> As noted, Rivette discloses searching patent databases and non-patent (e.g.

financial) databases.

> For the most part, existing patent related tools can process only information
> contained in patents. (It is noted, however, that the SmartPatent Workbench has
> functions to annotate patents with any other information, whether or not patent
> related, and has additional functions to search within annotations. These tools
> do not have functions for correlating, analyzing, and otherwise processing patent-
> related information with non-patent related information, including but not limited
> to corporate operational data, financial information, production information,
> human resources information, and other types of corporate information. Such
> non-patent information is critically important when evaluating the full strategic
> and tactical value and applicability of any given patent, or developing a corporate
> patent business strategy for gaining competitive advantage and increasing
> shareholder value based on patents. (Rivette, col. 2, lines 61+ - col. 3, line 9)

For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the financial information 216. (Rivette, col. 11, lines 4-7)

Rivette further describes in detail the how searching via the searching module

operates (Rivette, col. 25, line 39+ - col. 30, line 6).

For example, Rivette states:

The client searching module 710 supports a number of user interfaces for enabling a user to enter a search command. One user interface is a field driven graphical user interface (GUI) 902. Examples of field driven GUIs 902 are shown in Figs. 53 and 57. (Rivette, col. 26, lines 63-67).

Referring again to Fig. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI. (Rivette, col. 28, lines 29-31).

103

It has been established that rationales in addition to teaching-suggestion-

motivation (TSM) may be used in a finding of obviousness.

The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976).

Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents. The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements deprive prior inventions of their value or utility. *KSR v. Teleflex*, 127 S.Ct. 1727, 82 USPQ2d at 1396 (2007).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim 10 - 103 obviousness, Rivette

The limitation, "wherein said step of combining the results of the financial database searching step and the intellectual property database searching step, further comprises accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis" is made obvious by Rivette.

Rivette discloses a base device.

Rivette discloses a system, method and computer program product that maintains databases including patent databases and non-patent (e.g. financial) databases. (Rivette, col. 3, line 59+ - col. 4, line 3). Rivette also discloses a search module which interacts with a search engine to search these databases (Rivette, col. 25, line 39+ - col. 30, line 6). See discussion above. Rivette also discloses combining the results of searching patent databases and non-patent (e.g. financial) databases.

Rivette states:

For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the financial information 216. (Rivette, col. 11, lines 4-7)

Rivette suggests it would be beneficial to use automated tools to process patent and non-patent information to aid in making business decisions.

Accordingly, it would be very beneficial to have automated tools that automatically process patent related information and non-patent related information for making corporate business decisions. Existing patent-related tools do not have this capability. (Rivette, col. 3, lines 52-56)

Rivette also suggests conducting the searching according to commercial and well-known search engines.

The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306. The search engine 424 is any commercial and well-known search engine. (Rivette, col. 25, lines 39-43)

NOTE: The reference to databases 316 encompasses all databases, including the patent and financial, as can be shown by cross reference to Figs. 3-6 of Rivette.

A known technique was applicable to the base device.

Official Notice was taken of the following: Indexing patent data based on patent assignee; and financial data based on ticker information was well-known in the art. The knowledge among those providing commercial search engines to index ticker and financial information; patent assignee and patent information; and to link patent and financial information was also well-known. The documentary evidence supports the assertion that it was well-known for search engines (e.g., Dialog, LexisNexis, STN) to establish these types of linkages for search results at the time the invention was made (e.g., date restricted Google news archive search 1980-2000).

In light of these teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Rivette to provide a method further comprising: wherein said step of combining the results of the financial database searching step and the intellectual property database searching step, further comprises accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

Furthermore, Claim 10 applies a known technique to a known method ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Claims 1,2,7 and 14 - 103 obviousness, Rivette in view of Black

Re Claims 1 and 2:

The claimed invention recites:

Claim 1: In an on-line financial screening service, a method of <u>searching a financial database</u>, including data for a plurality of companies, <u>and an intellectual property database</u>, including data for a plurality of companies, <u>in order to find securities matching user search criteria and relevant intellectual property</u>, wherein the users access the database over the Internet, the method comprising:
searching the database for records matching financial search criteria defined by a user; and
relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one; and
reporting the matching records to the user, including at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-lYr,

Earnings per Share Growth-lYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio.

With respect to the language in the claim preamble, "In an on-line financial screening service, a method of searching a financial database, including data for a plurality of companies, and an intellectual property database, including data for a plurality of companies, in order to find securities matching user search criteria and relevant intellectual property, wherein the users access the database over the Internet, the method comprising:"

The similarities between Rivette and the claimed invention can generally be characterized by the other independent claims 3, 11, 16 and 17. First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s).   Second, Rivette discloses the claimed subject matter. Third, the language "including data for a plurality of companies" does not change the invention. See discussion supra.

In response to applicant's arguments, the recitation has not been given patentable weight in regards to 1 and 2 because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481

(CCPA 1951).

> The MPEP states:
>
> If the body of a claim fully and intrinsically sets forth all the limitations of the
> claimed invention, and the preamble merely states, for example, the purpose or
> intended use of the invention, rather than any distinct definition of any of the
> claimed invention's limitations, then the preamble is not considered a limitation
> and is of no significance to the claim construction. *Pitney Bowes, Inc. v. Hewlett-
> Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).
> See MPEP § 2111.02 II.

First, the body of the claim fully and intrinsically sets forth all the limitations of the

claimed invention. The steps or acts required to search a financial database are laid out

in their entirety in the body of the claim. Second, the claim does not provide a distinct

definition for any of the claimed invention's limitations. As noted supra, the meaning of

"including data for a plurality of companies" has multiple interpretations and the

intended definition is not clarified by the claimed invention. Third, as noted supra, the

language "including data for a plurality of companies" does not change the method

claimed or the associated system. For example, the step of searching of the database

does not have to be for records for a plurality of companies; the step of searching the

database does not have to be for records for any company; the step of searching the

database is for whatever records the user has defined which could be for completely

unrelated data stored in the database. For example, the structure of the database and

the other structural components interacting with the database does not change. As

noted supra, "including data for a plurality of companies" is only directed to the

compilation of data stored in the database and the system of Rivette would be just as capable of carrying out the claimed invention.

With respect to the language in the body of the claim, "relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one; and"

The similarities between Rivette and the claimed invention can generally be characterized by dependent claim 4. See discussion supra.

With respect to the language in the body of the claim, "reporting the matching records to the user, including at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-lYr, Earnings per Share Growth-lYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio. "

The similarities between Rivette, Black and the claimed invention can generally be characterized by 7 and 14. See discussion below.

Re Claims 7 and 14:

The claimed invention recites:

Re Claim 7: The method of claim 6, <u>wherein the updated information includes:</u>
<u>at least one item of financial data selected from the group consisting of Stock</u>
<u>Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio,</u>
<u>Earnings per Share Growth-lYr, Earnings per Share Growth-lYr, Insider Trades,</u>
<u>Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio, and</u>
at least one item of intellectual property data selected from the group consisting
of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract,
Inventor Country, Claim(s), Attorney or Agent, Description/Specification,
Assignee Name, Assignee State, Assignee Country, Issued US Classification,
International Classification, Application Serial Number, Application Date, Primary
Examiner, Assistant Examiner, Parent Case Information, Related US App. Data,

US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type.

Re Claim 14: The system of claim 11, <u>wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-lYr, Earnings per Share Growth-lYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio,</u> and
where said intellectual property database includes records having at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claim(s), Attorney or Agent, Description/Specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type.

The limitation "the at least one item of financial data selected from the group

consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio,

Cash/Price ratio, Earnings per Share Growth-lYr, Earnings per Share Growth-lYr,

Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio,

and" is made obvious by the teachings of Rivette in view of Black.

Rivette discloses a base device.

Rivette discloses a system, method and computer program product that

maintains databases including patent databases and non-patent (e.g. financial)

databases. (Rivette, col. 3, line 59+ - col. 4, line 3). Rivette also discloses a search

module which interacts with a search engine to search these databases (Rivette, col.

25, line 39+ - col. 30, line 6). See discussion above. Rivette also discloses combining

the results of searching patent databases and non-patent (e.g. financial) databases.

Rivette states:

For this and other purposes, the present invention includes functions for
automatically analyzing the patent information 204 in conjunction with the
financial information 216. (Rivette, col. 11, lines 4-7)

Rivette suggests it would be beneficial to use automated tools to process patent

and non-patent information to aid in making business decisions.

Accordingly, it would be very beneficial to have automated tools that
automatically process patent related information and non-patent related
information for making corporate business decisions. Existing patent-related
tools do not have this capability. (Rivette, col. 3, lines 52-56)

The prior art contained design incentives or market forces that would have

prompted adaptation of the known device.

Black discloses that technical and fundamental data including Stock Price,

Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per

Share Growth-lYr, Earnings per Share Growth-lYr, Insider Trades, Institutional Holdings

%, Price/Book Ratio, and Price/Cash Flow Ratio were tools or methodologies commonly

used in financial analysis.. (Black, Figs. 3 and 4; col. 1, lines 45-65; and col. 2, lines 8-

41 financial information).

Data including Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity

Ratio, Cash/Price ratio, Earnings per Share Growth-lYr, Earnings per Share Growth-lYr,

Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio

were tools or methodologies commonly used by companies, investors and third parties

etc. for purposes of analysis and decision-making with respect a the operations, value

and growth potential of companies.

In light of these teachings, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the teachings of Rivette in view of

Black to provide a method and system wherein the at least one item of financial data

selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio,

Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-IYr, Earnings per Share

Growth-IYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash

Flow Ratio.

As suggested by Rivette one would have been motivated to use publicly

available patent related information and non-patent related information (e.g., financial

information) to make business decisions.

Furthermore, a known work in one field of endeavor may prompt variations of it

for use in either the same field or a different one based on design incentives or other

market forces when the results are predictable to one of ordinary skill in the art. Thus,

claim 7 and 14 likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82

USPQ2d at 1396.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sara Chandler/
Examiner, Art Unit 3693
Sara Chandler

Conferees:
/Vincent Millin/
Vincent Millin
Appeals Conference Specialist

James Kramer
/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693